

REMARKS

Applicant respectfully requests reconsideration in view of the amendment and following remarks. The applicant has deleted the non-elected subject matter from the claims. Support for newly added claims 35 -40 can be found in the specification at page 9 and in the original claims 10 and 11. A fee of \$100.00 is required for the extra four claims (applicant has added six claims and cancelled two claims).

The applicant affirms their election of Group I without traverse.

Claims 22 and 23 were rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. Claims 16 and 20 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 12-14, 19 and 24-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michaud et al. U.S. Patent No. 5,973,055 ("Michaud"). The applicant respectfully traverses these rejections.

Claims 15 and 17-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Rejection of Claims 22 and 23

Claims 22 and 23 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, *i.e.*, results in a claim which is not a proper process claim under 35 U.S.C. 101. The applicant has rewritten claims 22 and 23 as newly added claims 35-40. The applicant believes that these claims are in compliance with 35 U.S.C. 101. For the above reasons, this rejection should be withdrawn.

Rejection of Claims 16 and 20

Claims 16 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The compositions are disclosed in the specification. The applicant believes that the claims 16 and 20 are enabled. For the above reasons, this rejection should be withdrawn.

Rejection Over Michaud

Claims 12-14 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michaud. The applicant's claimed invention requires 1,1,1,3,3-pentafluorobutane and more than 5 % of weight of at least one non-flammable perfluorocarbon compound. Michaud does not teach this. Michaud teaches at col. 5, lines 10-50:

a hydrophobic active agent

a solvent or vector fluid compatible with the hydrophobic active

agent or ingredient,

characterized in that the solvent or vector fluid comprises at least one fluorinated hydrocarbon, liquid at ambient temperature, chosen from

(1) the (perfluoroalkyl)-ethylenes containing 6 to 10 carbon atoms,

(2) the 1H-hydrogenoperfluoroalkanes containing 6 to 8 carbon atoms,

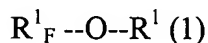
(3) 1,1,1,2,3,4,4,5,5,5-decafluoropentane,

(4) n-perfluorohexane,

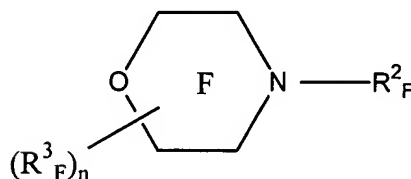
(5) 1,1,1,3,3-pentafluorobutane of formula $\text{CF}_3\text{--CH}_2\text{--CF}_2\text{--CH}_3$,

(6) 3,3,3,2,2-pentafluoro-1-propanol of formula $\text{CF}_3\text{--CF}_2\text{--CH}_2\text{OH}$,

(7) alkyl and perfluoroalkyl ethers of formula (1):



in which R_F^1 is a perfluoroalkyl radical comprising from 2 to 6 carbon atoms and R^1 is an alkyl radical comprising from 1 to 4 carbon atoms, the (N-perfluoroalkyl-perfluoromorpholines being possibly substituted by one or more perfluoroalkyl radicals of formula (II)



in which:

R_F^2 and R_F^3 , identical or different, represent a perfluorinated aliphatic radical, linear or branched, comprising from 1 to 4 carbon atoms;

n is a whole number of 0 to 8;

the symbol F, within the cycle, means that the saturated cycle is fully fluorinated, that is to say that all the carbon atoms are bound to fluorine atoms or, possibly, to one or two R^3_F radical(s), and their mixtures; and in that the hydrophobic active agent is a compound of organopolysiloxane type.¹ (emphasis added)

Groups (1), (2) and (7) require many more possibilities. These groups are almost endless in the possibilities. Again, these solvents are mixed with a hydrophobic agent. Table I at column 9, illustrates the results with examples 2-14. There is no example of a mixture of two or more solvents. Table I shows 25 % of a solvent such as **1,1,1,3,3-pentafluorobutane** (example 2); $C_4F_9-CH=CH_2$ (example 3); $C_4F_9-CH=CH_2$ (example 4); $C_6F_{13}-CH=CH_2$ (example 5); $C_6H_{13}-H$ (example 6? if H_{13} if F_{13}); $CF_3-(CHF)_2-CF_2CF_3$ (example 7) and nC_6F_{14} (example 9). These are the only examples out of the 14 examples that use **1,1,1,3,3-pentafluorobutane or perfluorocarbon** compound, but there are **NO** examples that have two different solvents, let alone **1,1,1,3,3-pentafluorobutane and perfluorocarbon** compound as is required by the applicant's claimed invention.

The Examiner must consider the reference as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** (In re Gordon, 733 F.2d 900, 902,


¹ The numbers were inserted by the applicant.
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221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the reference itself must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicant disagrees with the Examiner why one skilled in the art with the knowledge of the reference would selectively modify the reference in order to arrive at the applicant's claimed invention. The Examiner's argument is clearly based on hindsight reconstruction. For the above reasons, this rejection should be withdrawn.

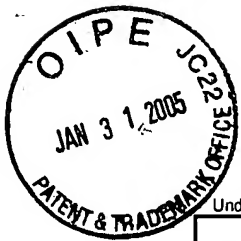
In view of the above amendment, applicant believes the pending application is in condition for allowance.

A one month extension fee has been paid. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05129-00079-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 
Ashley I. Pezzner

Registration No.: 35,646
CONNOLLY BOVE LODGE & HUTZ LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, Delaware 19899
(302) 658-9141
(302) 658-5614 (Fax)



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PTO/SB/92 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031

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Application No. (if known): 10/816766

Attorney Docket No.: 05129-00079-US

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One Month Request for Extension of Time Under 37 CFR 1.136(a) (1 page)

Amendment In Response To Non-Final Office Action

Charge \$120.00 to deposit account 03-2775